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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/551,318	05/16/2006	Jean-Marie Adam	ELI2-22867/A/PCT	6527
<div>324 7590 02/12/2009</div> <div>JoAnn Villamizar</div> <div>Ciba Corporation/Patent Department</div> <div>540 White Plains Road</div> <div>P.O. Box 2005</div> <div>Tarrytown, NY 10591</div>				
<div>EXAMINER</div> <div>ANGEBRANDT, MARTIN J</div>				
<div>ART UNIT PAPER NUMBER</div> <div>1795</div>				
<div>MAIL DATE DELIVERY MODE</div> <div>02/12/2009 PAPER</div>				

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/551,318

**Applicant(s)**

ADAM ET AL.

**Examiner**

Martin J. Angebrannt

**Art Unit**

1795

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 9/29/05, 5/16/06 & 2/9/06.  
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-19 is/are pending in the application.  
4a) Of the above claim(s) 2,4,11-15,18 and 19 is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1,3,5-10,16 and 17 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☒ Claim(s) 1-19 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_  
5) ☐ Notice of Informal Patent Application  
6) ☐ Other: \_\_\_\_\_

1. This application contains claims directed to more than one species of the generic invention. These species are deemed to lack unity of invention because they are not so linked as to form a single general inventive concept under PCT Rule 13.1.

The species are as follows:

The various compounds embraced by the formulae I, II or III in claim 1 used in optical recording media

Applicant is required, in reply to this action, to elect a single species to which the claims shall be restricted if no generic claim is finally held to be allowable. The reply must also identify the claims readable on the elected species, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered non-responsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

2. The claims are deemed to correspond to the species listed above in the following manner:

The various compounds embraced by the formulae I, II or III in claim 1 used in optical recording media

The following claim(s) are generic: Claim 1.

The species listed above do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, the species lack the same or corresponding special technical features for the following reasons: Any feature which

3. During a telephone conversation with Joseph C. Suhadolnik (56,880) on February 9, 2009 a provisional election was made with traverse to prosecute the invention of the compound of example 3 of the instant specification, claims 1,3,5-10 and 16-17. Affirmation of this election must be made by applicant in replying to this Office action. Claims 2,4,11-15 and 18-19 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.
4. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

The examiner has required restriction between product and process claims. Where applicant elects claims directed to the product, and the product claims are subsequently found allowable, withdrawn process claims that depend from or otherwise require all the limitations of the allowable product claim will be considered for rejoinder. All claims directed to a nonelected process invention must require all the limitations of an allowable product claim for that process invention to be rejoined.

In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103 and 112. Until all claims to the elected product are found allowable, an otherwise proper

restriction requirement between product claims and process claims may be maintained.

Withdrawn process claims that are not commensurate in scope with an allowable product claim will not be rejoined. See MPEP § 821.04(b). Additionally, in order to retain the right to rejoiner in accordance with the above policy, applicant is advised that the process claims should be amended during prosecution to require the limitations of the product claims. **Failure to do so may result in a loss of the right to rejoiner.** Further, note that the prohibition against double patenting rejections of 35 U.S.C. 121 does not apply where the restriction requirement is withdrawn by the examiner before the patent issues. See MPEP § 804.01.

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1,3,5-10 and 16-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kambe et al. '843, in view of Maruyama et al., JP 10-006651.

Kambe et al. '843 teaches in column 31 the compound C-13, where the counterion is a cyanine dyes and the substituent on ring B is hydroxyl and dimethylamino and the substituents on ring A are nitro and hydroxy. The counterions may be inorganic counterions, ammonium or cyanine dye (22/35-44). The rings may be substituted with nitro, hydroxyl or amino and the like (6/14-52). Dye 22 is similar, but uses an ammonium cation and has two nitro groups. Medium of sample 215 uses dye 22 to form a medium having the structure of a polycarbonate substrate with a groove pitch of 0.74/0.8 microns, the dye layer coated from TFP, an Au reflective layer and a

protective layer and a 635 nm laser is used for recording.. (78/42-80/18). The use of record light in the 635-680 range is disclosed as most preferred/typical (75/25-40)

Maruyama et al., JP 10-006651 teaches azo dyes of formula I, where the R groups may be hydrogen, nitro, halogen, amino, monoalkylamino, dialkylamino, hydroxyl or alkoxy groups and the counter ion can be hydrogen, metals, ammoniums or the like. Metals disclosed include Ca, Mg, Zn, Cu, Ni, Pd, Fe, Pb, Co, Pt, Cd, Ru, Al, Cr, Ga, Tl and Mn [0008-0011]. Dye 2 uses  $\text{Ca}^{2+}$  (page 2) and dye 4 uses  $\text{Mg}^{2+}$  (page 6).

It would have been obvious to one skilled in the art to modify the medium of sample 215 by replacing the amino group with hydroxyl, based upon the disclosure of equivalence at 6/14-52 in Kambe et al. and as [0008], using only one nitro group positioned para to the azo linkage, noting this is used in the anion of compound C-13, and using Co as the counterions noting the direction in Kambe et al. to inorganic cations as the counterion and the teaching in Maruyama et al., JP 10-006651 to the use of the cations disclosed as useful form the central metal [0008,0011] and dyes 2 and 4, with a reasonable expectation of forming a useful optical recording medium having similar performance to that of sample 215. The examiner notes the disclosed cations of the instant specification include metals, ammonium, cationic dyes and hydrogen [0052].

The examiner notes the data at [0142] of the prepub of the instant application, but notes that the alleged benefit is not tied to the performance of the medium in the statements and the compound 22 has a high reflectivity and modulation with low jitter and optimum recording power. It may be that as the applicant has considered dye 2, which is equivalent to dye 22 of the Kambe et al. reference, that they may have performance data on hand which could be incorporated into a declaration to support a position of unobvious results when using the

inventive dye. Further it would have been obvious to use other laser wavelengths in the 635-680 nm range based upon the direction at (75/25-40) in Kambe et al.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Martin J. Angebranndt whose telephone number is 571-272-1378. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Huff can be reached on 571-272-1385. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Martin J Angebranndt/  
Primary Examiner, Art Unit 1795

Martin J Angebranndt  
Primary Examiner  
Art Unit 1795

2/11/09